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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,991	12/06/2001	Yuuji Saiki	020606	3509

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EXAMINER
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LAVARIAS, ARNEL C

ART UNIT	PAPER NUMBER
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2872

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/27/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/015,991

Applicant(s)

SAIKI ET AL.

Examiner

Arnel C. Lavarias

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4,9,10,17-20 and 22-28 is/are pending in the application.
- 4a) Of the above claim(s) 17-20 and 22-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,9,10,27 and 28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Arguments*

1. The Applicants' arguments filed 2/1/07 have been fully considered but they are not persuasive.
2. The Applicants argue that, with respect to Claim 1, as well as Claims 2-4, 9-10, 27-28 which depend on Claim 1, the combined teachings of Nagahama et al. and Murata et al. fail to provide any teaching, suggestion, or motivation regarding a temporary protective film as used in the claimed invention. The Examiner respectfully disagrees. In particular, the Examiner notes that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the instant case, it is noted that the teachings of Murata et al. is being relied upon to evidence that known conventional protective films utilized on optical members such as polarizers may be made transparent, as well as include a surface having a surface roughness Ra of from 0.03 to 1  $\mu\text{m}$  which does not substantially alter the transparent properties of the protective film (See specifically 11 in Figure 1; 21 of Figure 2; col. 3, lines 15-24; col. 3, line 38-col. 4, line 21 of Murata et al.).
3. The Examiner further notes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where *there is some teaching, suggestion, or motivation to do so found either in the references*

*themselves or in the knowledge generally available to one of ordinary skill in the art.*

See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Murata et al. explicitly discloses that the formation of the surface roughness on the protective film, which is attached to the optical member such as a polarizer, provides the antiglare effect, and hence the high contrast and lack of glittering. Further, Murata et al. states that applications such as displays and liquid crystal panels could have such a polarizer with protective film with surface roughness mounted thereto, and thus enjoy the antiglare, high contrast, and lack of glittering exhibited by the polarizer with the protective film with surface roughness (See col. 2, lines 27-39; col. 3, line 38-col. 4, line 43; col. 6, lines 14-24; col. 7, lines 22-35 of Murata et al.).

4. Claims 1-4, 9-10, 27-28 are again rejected as follows.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3, 9-10, 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagahama et al. (WO00/44841), of record, in view of Murata et al. (U.S. Patent No. 5886819), of record.

Nagahama et al. discloses an optical member (See Figure 7) in which a surface of an optical material (See 15, 16 in Figure 7) is bonded to and covered with a protective film (See 11, 12 or 14, 11 in Figure 7), wherein the protective film comprises a protective base and an adhesive layer disposed on the protective base so that the protective base can be released together with the adhesive layer from the optical material (See Abstract; 11, 12 or 11, 14 in Figure 7). Nagahama et al. additionally discloses the protective film being disposed on one surface of the optical material (See for example 11, 12 in Figure 7), a separator being provided on an adhesive layer disposed on the other surface of the optical material (See 11, 14 in Figure 7) so that the separator can be released from the adhesive layer (See 17 in Figure 7), the optical material comprising a polarizing plate (See 16 in Figure 7), a liquid display having the optical member (See Abstract); the protective film thickness not being more than 300  $\mu\text{m}$  (See for example Page 7 (Page 14 of translation of Nagahama et al.), as well as various disclosed examples of the protective film on Pages 17-27 (Pages 31-47 of the translation of Nagahama et al.)); and the protective film being a light-transmitting protective film (See Abstract; various examples disclosed).

Nagahama et al. does not explicitly disclose the protective film being transparent and having an outer surface roughness  $R_a$  of from 0.03 to 1  $\mu\text{m}$  that does not substantially alter the transparent properties of the protective film. However, Murata et al. teaches a conventional surface protecting antiglare film for use in polarizing films (See for example Abstract of Murata et al.; Figures 1-2). In particular, Murata et al. teaches that the surface protective antiglare film includes a highly transparent substrate (See 11 in Figure 1; 21 in Figure 2; col. 3, lines 15-24), such as a PET or TAC film, that is adhered to a

polarizing layer (See 24 in Figure 2; col. 5, line 53-col. 6, line 11). Further, Murata et al. teaches that an outer surface of the surface protective antiglare film may include a surface roughness Ra of 0.03-0.3 micron with a corresponding haze value of 1-25 (See col. 3, line 38-col. 4, line 21). These values are very much in the same order as that of the instant application, and it is expected that the transparent properties of the protective antiglare film will not be significantly altered due to the presence of the surface roughness, as is the case for the instant application (See for example Applicants' declaration dated 4/29/05). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the protective film of Nagahama et al., be transparent and have an outer surface roughness Ra of from 0.03 to 1  $\mu\text{m}$  that does not substantially alter the transparent properties of the protective film, as taught by Murata et al., to ease or simplify inspection of the underlying attached optical material (e.g. a polarizer element) due to a relatively higher contrast, while reducing or eliminating possible glittering effects during viewing.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nagahama et al. in view of Murata et al. as applied to Claim 1 above, and further in view of Iwata et al. (U.S. Patent No. 6111699), of record.

Nagahama et al. in view of Murata et al. discloses the invention as set forth above in Claim 1, except for the optical material further including at least one of a retardation plate and a brightness enhancement plate. However, Iwata et al. discloses an optical member (See for example Figures 6B, 7, 11) in which an adhesive layer (See 34 of Figure 6B) is disposed on an outermost surface of an optical material (See 12 in Figure 6B) is

provisionally bonded to and covered with a separator (See 36 in Figure 6B). Iwata et al. additionally discloses the separator being disposed on one surface of the optical material (See Figures 6B, 7), a protective film being provided on the other surface of the optical material (See 18, 32 in Figures 6B) having an outer surface roughness Ra of at least 0.03  $\mu\text{m}$  (See Abstract; col. 5, lines 50-65), the optical material comprising a polarizing plate and at least one of a retardation plate and a brightness enhancement plate (See for example 42 in Figure 7; 42, 86 in Figure 11), and a liquid crystal display having the optical member (See for example col. 10, line 25-32). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the optical material further include at least one of a retardation plate and a brightness enhancement plate, as taught by Iwata et al., in the optical member of Nagahama et al. in view of Murata et al., for the purpose of reducing the cost and complexity of manufacturing the liquid crystal display panel.

### *Conclusion*

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arnel C. Lavarias whose telephone number is 571-272-2315. The examiner can normally be reached on M-F 9:30 AM - 6 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephone B. Allen can be reached on 571-272-2434. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Arnel C. Lavarias  
Primary Examiner  
Group Art Unit 2872  
3/21/07

  
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